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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/863,066	05/23/2001	Toshiyuki Nagaoka	P 281268 OL96001N-US	7597

7590 09/25/2003  
PILLSBURY WINTHROP LLP  
1600 TYSONS BOULEVARD  
MCLEAN, VA 22102

EXAMINER

CHERRY, EUNCHA P

ART UNIT	PAPER NUMBER
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2872

DATE MAILED: 09/25/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

09/863,066

Applicant(s)

NAGAOKA, TOSHIYUKI

Examiner

EUNCHA P. CHERRY

Art Unit

2872

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 03 July 2003.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-18 is/are pending in the application.
- 4a) Of the above claim(s) 4,5,7,8 and 18 is/are withdrawn from consideration.
- 5) ☒ Claim(s) 1 and dependent claims thereof is/are allowed.
- 6) ☒ Claim(s) 2, 3 and dependent claims thereof is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. §§ 119 and 120

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

## Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_

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**DETAILED ACTION**

***Claim Rejections - 35 USC § 102***

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless -

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

2. Claims 2, 3, 6/2, 6/3, 9/2, 10/9/2, 11/2, 12/2, 16/2 and 17 are rejected under 35 U.S.C. 102(b) as being anticipated by Novis et al.

Novis et al discloses a portable image display having data communication means, which comprises a speaker portion for catching sounds, a microphone portion for picking up sounds, an image display device and a viewing optical system for forming an exit pupil to view an image displayed on the image display device and having a generally positive refracting power, wherein (Figure 1): the portable image display has a body (10) and the frame member (12) that is independent of the body and is receivable in the body (see Fig. 2), the viewing optical system (Fig. 1, 20) is constructed of at least one prism member (column

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8, lines 31-49 and Fig. 11) comprising an entrance surface into a prism, at least one reflecting surface, and an exit surface, wherein the reflecting surface being defined by a rotationally asymmetric surface shape which inherently capable of making correction for decentration aberrations (see Fig. 11). The prism portion and the image display device are received in a body (see Fig. 1). The portable image display comprises a data storage device (see Fig. 6) and a light source (Fig. 6), wherein the storage device is built in the body (inherent). The microphone portion and the speaker portion extend from the body of the portable image display (see Fig. 1). The image is turned on the basis of whether the body of the portable image display is held by the right hand or left hand (inherent because any cellular phone can be turned on or off with right or left hands, the image is shown on the display portion as the phone is turned on).

#### ***Allowable Subject Matter***

3. Claims 1 and dependent claims thereof are allowed.

#### ***Response to Arguments***

4. Applicant's arguments filed 7/3/03 have been fully considered but they are not persuasive. Applicant argues that

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the prior art does not have the reflecting portion that is held by a frame member, which is independent of the body. Examiner disagrees. The reflecting portion of the prism is held by a frame member as shown in Fig. 10 and that frame member is independent of the body 11 of Fig. 1. Therefore, the rejection is deemed proper. Applicant argues that the prior art is not an image pickup device. Examiner disagrees. The portable electronic device of the prior art can be considered as an image pickup system, because the element 20 displays an image that satisfies the limitation of the claim.

### ***Conclusion***

5. Any inquiry concerning this communication or earlier communications from the examiner should be directed to EUNCHA P. CHERRY whose telephone number is 703-305-0997. The examiner can normally be reached on M-F 6:30-4:00, alternate Fridays off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, DREW DUNN can be reached on 703-305-0024. The fax phone numbers for the organization where this application or proceeding is assigned are 703-308-7722 for regular communications and 703-308-7724 for After Final communications. Any inquiry of a general nature or

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relating to the status of this application or proceeding should  
be directed to the receptionist whose telephone number is 703-  
308-0956.

A handwritten signature in black ink, appearing to read 'Euncha P. Cherry', written in a cursive style.

EUNCHA P. CHERRY  
Primary Examiner  
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